



1/E AF 1

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0974-00

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3689
)
Application No.: 10/024,333) Examiner: Gerardo Araque, Jr.
)
Filed: December 21, 2001) Confirmation No.: 4711
)
For: METHODS AND SYSTEMS FOR)
GENERATING A PROGNOSIS)

Mail Stop Appeal Brief--Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on July 2, 2008.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$255.00 (Small Entity)

☒ \$510.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee \$510.00

Minus Previously Paid
Appeal Brief Fee \$500.00

Total Fee Due \$ 10.00


Adjustment date: 09/03/2008 02EWDIE1
06/14/2007 YPOLITE1 00000004 10024333
01 FC:1402 ~~200.00~~ 0P

☒ Enclosed is a check for \$10.00 to cover the above fee.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to Deposit Account No. 06-0916.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 2, 2008

By: 
Anthony M. Gutowski
Reg. No. 38,742



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0974-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3689
)
Application No.: 10/024,333) Examiner: Gerardo Araque, Jr.
)
Filed: December 21, 2001) Confirmation No.: 4711
)
For: METHODS AND SYSTEMS FOR)
GENERATING A PROGNOSIS)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

This is an appeal to the Board of Patent Appeals and Interferences ("the Board") from the Final Office Action dated April 15, 2008, ("Final Office Action"), rejecting claims 1-48, in the above-referenced patent application. In accordance with M.P.E.P. § 1204.01, the prior payment of the \$500.00 Appeal Brief fee previously filed on June 13, 2007, should be applied to this Appeal Brief. Appellants submit herewith payment of \$10.00, which is the difference between the currently required Appeal Brief fee of \$510.00 under 37 C.F.R. § 1.17(c) and the previously paid fee of \$500.00.

A Notice of Appeal was filed on July 2, 2008. This Appeal Brief is being timely filed. If any additional fees are required, or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

09/03/2008 SZEWDIE1 00000074 10024333

01 FC:1402

510.00 0P

I. Real Party In Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office, beginning at Reel 012934, Frame 0114, on May 29, 2002.

II. Related Appeals and Interferences

Appellants, Appellants' legal representative, and Assignee are aware of no other appeals, interferences, or judicial proceedings that may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. Status Of Claims

Claims 1-48 are pending in this application. Claims 1-48, as set forth in the Claims Appendix, were rejected in the Final Office Action and the rejections applied to those claims are at issue in this appeal.

IV. Status Of Amendments

No amendments have been filed subsequent or in response to the Final Office Action.

V. Summary Of Claimed Subject Matter

A. Independent claim 1

Independent claim 1 recites a method of enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20¹. The method also comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method further comprises generating, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method further comprises outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

B. Independent claim 31

Independent claim 31 recites a system for enabling determination of prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also

¹ The designations of reference numerals and identifications of portions of the specification and drawings in this Brief are merely intended to facilitate explaining how the originally-filed application provides exemplary disclosure relating to the claimed subject matter. These designations and references are exemplary and non-exhaustive, and they should not be construed as limiting the claims.

comprises a database for storing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises a driver for outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

C. Independent claim 32

Independent claim 32 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises means for receiving at least one representation of the subject's external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.20; Fig. 8C, item 60; Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of

said at least one beauty product. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The system further comprises means for outputting the prognosis to enable the subject to receive the prognosis. This is a means-plus-function recitation and the corresponding structure, material, or act is disclosed in Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

D. Independent claim 47

Independent claim 47 recites a system for enabling determination of a prognosis for an external body condition of a subject. The system comprises a memory for receiving at least one representative image of the subject's external body condition. Fig. 1; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The system also comprises a secondary storage storing a mesh frame representative of at least one part of human anatomy. Page 11, lines 4-10. The system further comprises a database containing information on how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C; Fig. 8D; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The system further comprises a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product. Fig. 2; page 17, line 13 - page 18, line 4. The system further comprises a driver for outputting the prognosis image to enable the subject to view the prognosis image. Page 19, lines 7-15.

E. Independent claim 48

Independent claim 48 recites a computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject. The method comprises receiving at least one representation of the subject's external body condition. Fig. 1, item S.10; page 8, lines 10-11; page 9, line 18 - page 11, line 20. The method comprises maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition. Fig. 1, item S.20; Fig. 8C, item 60, Fig. 8D, item 80; page 8, lines 12-13; page 11, line 21 - page 15, line 7. The method comprises generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product. Fig. 1, item S.30; page 8, lines 13-15; page 15, line 8 - page 17, line 3. The method comprises outputting the prognosis to enable the subject to receive the prognosis. Fig. 1, item S.40; Figs. 2, 3; page 8, lines 15-16; page 17, line 4 - page 19, line 15.

VI. Grounds of Rejection to be Reviewed on Appeal

The following grounds of rejection are to be reviewed:

A. Claims 31-36, 38-45, and 47 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,081,611 to Linford et al. ("Linford").

B. Claims 1-30, 37, 46, and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Linford in view of the archived Internet website of Proactiv (http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php) ("Proactiv").

VII. Argument

**A. The Rejection of Claims 31-36, 38-45, and 47 Under
35 U.S.C. § 102(b) Based on Linford Should Be Reversed**

1. Claim 31

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P § 2131; *see In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Independent claim 31 recites, among other things, "a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition," and "a processor for modifying [a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product." In the Final Office Action at page 2, the Examiner asserts that Linford discloses the recited subject matter in column 5, lines 30-57. Appellants respectfully disagree.

Linford discloses "[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit" and that the memory "generally

comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. Thus, Linford fails to disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In the Final Office Action at page 15, the Examiner asserts, without citing any authority, that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention from the prior art.” Appellants submit that, regardless of whether the Examiner assertion has any merit, the Final Office Action fails to address the structural differences between claim 1 and Linford. As explained above, the Linford reference fails to mention a “database” or disclose any component for storing information on how use of at least one beauty product affects evolution of an external body condition. This is because Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure of any modification of the image being based on information stored in a database. This is at least one example of a structural difference between the claimed invention and

Linford. In the Final Office Action at page 7, with respect to claims 1 and 48, the Examiner even admits that “Linford . . . fails to disclose: maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.” The Examiner’s own admission confirms that Linford does not disclose “a database for storing information on how use of at least one beauty product affects evolution of [an] external body condition,” as recited in independent claim 31.

In addition, because Linford does not disclose a database that stores information on how use of at least one beauty product would affect evolution of an external body condition, Linford fails to disclose “a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31. As explained above, Linford enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. A system for handling manual editing of a preoperative image is not the same as “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 31.

For at least the above reasons, Linford does not support the § 102(b) rejection of independent claim 31. Therefore, the § 102(b) rejection of independent claim 31 based on Linford should be reversed.

2. *Claim 32*

Independent claim 32, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 32 recites, among other things, “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that], based on information contained in the database, . . . generate[s] at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32.

For at least above reasons, the § 102(b) rejection of independent claim 32 based on Linford should be reversed.

3. *Claim 47*

Independent claim 47, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 31. For example, independent claim 47 recites, among other things, “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product.” As explained above with respect to independent claim 31, Linford fails to disclose “a database [that] stor[es] information on how use of at least one beauty product affects evolution of [an] external body condition,” and “a processor [that] modif[ies a] representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” Thus, Linford also fails to disclose “a database containing information on how use of at least one beauty product affects evolution of the external body condition,” and “a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product,” as recited in independent claim 47.

Independent claim 47 recites further distinctions from Linford. For example, independent claim 47 recites “a secondary storage storing a mesh frame representative of at least one part of human anatomy.” In the Final Office Action at page 5, the

Examiner asserts that Linford discloses the recited subject matter in column 5, lines 30-57. Appellants respectfully disagree.

As explained above with respect to independent claim 31, Linford discloses “[a] processing unit . . . controlled by an operating system [and a] memory . . . connected to the processing unit” and that the memory “generally comprises . . . random access memory (RAM), read only memory (ROM), magnetic storage media such as a hard drive, floppy disk, or magnetic tape.” Linford, col. 5, lines 30-36. Linford also discloses “an image capture board . . . coupled to the processing unit . . . , a monitor . . . , video source . . . , and printer.” Linford, col. 5, lines 44-48. However, the Linford reference fails to even mention “a mesh frame representative” or disclose any component for storing “a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47. Thus, Linford fails to disclose “a secondary storage storing a mesh frame representative of at least one part of human anatomy,” as recited in independent claim 47.

For at least above reasons, the § 102(b) rejection of independent claim 47 based on Linford should be reversed.

4. Claims 33-36 and 38-45

Claims 33-36 and 38-45 depend from independent claim 32. Thus, claims 33-36 and 38-45 incorporate the elements that are missing from Linford, as discussed above. Accordingly, the rejection of dependent claims 33-36 and 38-45 under 35 U.S.C. § 102(b) should be reversed.

**B. The Rejection of Claims 1-30, 37, 46, and 48 Under
35 U.S.C. § 103(a) Based on Linford in view of Proactiv Should
Be Reversed**

The rejection of claims 1-30, 37, 46, and 48 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

1. *Claim 1*

Independent claim 1 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “generating, based on both [a] received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.”

As explained above, Linford is directed to “an aesthetic imaging system . . . for use in editing digital images” that enables a physician to manually edit a preoperative image during a consultation with a patient in attendance. Linford, Abstract and col. 1, lines 51-53. A physician relies on his own knowledge of how a cosmetic surgery would affect a preoperative image, and there is no disclosure or suggestion of any modification of the image being based on information stored in a database. In the Final Office Action at 7, the Examiner thus correctly observes that Linford fails to disclose “maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition.” In addition, because Linford does not teach “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” Linford does not also teach or suggest “generating, based on both the received representation and information contained in the database, at least on prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 1 (emphasis added).

Proactiv fails to cure the deficiencies of Linford. In the Final Office Action at page 7, the Examiner asserts that “Proactiv [purportedly] discloses how the use of a beauty product affects the evolution of an external body condition, wherein the information is

stored in a database.” (emphasis omitted). Appellants respectfully disagree and submit that Proactiv shows web pages containing text and graphic describing beauty products. The pages, by themselves, do not teach or suggest that “the information is stored in a database,” as asserted by the Examiner.

Further, even assuming, *arguendo*, that Proactiv teaches that “the information is stored in a database,” as asserted by the Examiner, nothing in Linford or Proactiv teaches or suggests that the information in a database is used, in any way, to generate at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty product. The information in text (e.g., sentences in paragraphs), as shown in web pages of Proactiv, is not structured in any way that would appear to be used in generating at least one prognosis reflecting predicted changes in an external body condition after use of one or more beauty product.

In the Final Office Action at 15, the Examiner asserts that “Linford does disclose that information stored in a database is used to create the post-operative image,” without providing any indication of the basis for the Examiner’s assertion. (Emphasis omitted.) Appellants respectfully disagree and submit that the Examiner mischaracterizes Linford because the Linford reference does not even mention a “database” or disclose any maintaining of information on how use of at least one beauty product affects evolution of an external body condition.

In view of the above-noted deficiencies and mischaracterizations of the Linford and Proactiv references, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of independent claim 1. Therefore, the Final Office Action

has failed to clearly articulate a reason why claim 1 would have been purportedly obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claim 1, and the rejection under 35 U.S.C. § 103(a) should be reversed.

2. *Claim 48*

Independent claim 48, although of different scope, recites subject matter that is similar to the subject matter recited in independent claim 1. For example, independent claim 48 recites, among other things, “maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition,” and “generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product.” As explained above with respect to independent claim 1, a *prima facie* case of obviousness has not been established with respect to independent claim 1. For at least reasons similar to the reasons set forth above with respect to independent claim 1, a *prima facie* case of obviousness has not established with respect to independent claim 48, and therefore, Linford and Proactiv, taken alone or in combination, fail to support the rejection under 35 U.S.C. § 103(a). Accordingly, the rejection under 35 U.S.C. § 103(a) should be reversed.

3. *Claims 2-30*

Claims 2-30 depend from independent claim 1. Claims 2-30 are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, the rejection of dependent claims 2-30 under 35 U.S.C. § 103(a) should be reversed.

In addition, the dependent claims recite further distinctions over the cited references.

i. Claims 17-19

Dependent claim 17 recites, among other things, a “beauty product [that] is chosen from skin products, hair products, and nail products.” Dependent claim 18 recites, among other things, a “beauty product [that] comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.” Dependent claim 19 recites, among other things, a “hair product chosen from a conditioner and a shampoo.” In the Final Office Action at page 11, the Examiner admits that the “combination of Linford and Proactiv fails [to] disclos[e] wherein the beauty product is chosen from skin products, hair products, and nail products, moisturizers, wrinkle removers, and hair product chosen from a conditioner and a shampoo.” (emphasis omitted). The Examiner, however, alleges, in a clearly improper hindsight fashion that “it would have been obvious to one having ordinary skill in the art that a variety of beauty products can be used and all would produce the same predictable result of generating a prognosis showing the effects of using a beauty product.” The hindsight reasons identified by the Examiner are, at best, conjectural and not supported by any findings. For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be reversed.

ii. Claim 25

Dependent claim 25 recites, among other things, “rendering [a] prognosis on a three-dimensional mesh image.” Linford discloses that “another view option provided to the user in the aesthetic imaging system is an Emboss option.” Linford, col. 25, lines 19-20. “The emboss option displays an image that is *similar* to an etching made of

a three-dimensional raised surface.” Linford, col. 25, lines 25-27 (emphasis added).

Thus, although “similar,” the emboss option still portrays an image as a two dimensional image, “with the depth of the raised surface indicated by a darker shade of gray.” As shown in FIGS. 6, 7A-E, 8A-E, 9D-G, 11, 14A-D, 15A-C, 16, 17, 18A-C, 19, and 20 of Linford, none of the images is a three-dimensional mesh image. For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be reversed.

4. *Claims 37 and 46*

Claims 37 and 46 depend from independent claim 32. As discussed above with respect to independent claim 32, Linford fails to disclose “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 32. Proactiv also does not disclose or suggest these features recited in claim 32. As explained above with respect to independent claim 1, Proactiv fails to teach or suggest “maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “generating, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product,” as recited in independent claim 1. Thus, Proactiv also fails to teach or suggest “means for maintaining, in a database, information of how use of at least one beauty product affects evolution of [an] external body condition,” and “means for generating, based on both the representation

and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product," as recited in independent claim 32, and thus fails to cure the deficiencies of Linford. Accordingly, a prima facie case of obviousness has not been established with respect to claims 37 and 46, and the rejection under 35 U.S.C. § 103(a) should be reversed.

VIII. Conclusion

For the reasons given above, claims 1-48 are patentable over the cited references. The Board is therefore respectfully requested to reverse the outstanding rejections under 35 U.S.C. §§ 102(b) and 103(a), so that those pending claims may be allowed.

To the extent any additional extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due which are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 2, 2008

By:



Anthony M. Gutowski
Reg. No. 38,742

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
Customer No. 22,852

IX. Claims Appendix

1. A method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:
 - receiving at least one representation of the subject's external body condition;
 - maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;
 - generating, based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and
 - outputting the prognosis to enable the subject to receive the prognosis.
2. The method of claim 1, wherein the at least one representation defines the external body condition.
3. The method of claim 1, wherein the at least one representation comprises at least one representative image of the external body condition.
4. The method of claim 1, wherein the prognosis comprises a prognosis image.
5. The method of claim 4, wherein the prognosis image comprises a three-dimension prognosis image.

6. The method of claim 1, further comprising enabling the subject to receive instructions relating to obtaining of the representation.

7. The method of claim 6, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

8. The method of claim 1, further comprising constructing an image based on the representation, wherein said generating of the prognosis comprises comparing the constructed image to the information in the database.

9. The method of claim 3, wherein the information in the database comprises image morphing information, and wherein said generating of the prognosis comprises morphing the representative image based on the image morphing information.

10. The method of claim 1, wherein the representation is received via a network, and wherein the subject is located at a location remote from a location where the database is maintained.

11. The method of claim 1, wherein the representation is stored in a data storage device, and wherein said receiving of the representation comprises receiving the data storage device.

12. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

13. The method of claim 12, wherein the outputting further comprises outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

14. The method of claim 1, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

15. The method of claim 14, wherein the outputting further comprises outputting usage information to enable the subject to be informed about the manner of beauty product usage relating to the information in the database used to generate the prognosis.

16. The method of claim 14, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, frequency of use of the product, the length of time between each use of the product, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

17. The method of claim 1, wherein the beauty product is chosen from skin products, hair products, and nail products.

18. The method of claim 1, wherein the beauty product comprises a skin product chosen from moisturizers, wrinkle removers, and exfoliates.

19. The method of claim 1, wherein the beauty product comprises a hair product chosen from a conditioner and a shampoo.

20. The method of claim 1, further comprising outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.

21. The method of claim 1, wherein the generating the prognosis comprises comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.

22. The method of claim 1, wherein the outputting the prognosis comprises transmitting the prognosis via a network.

23. The method of claim 1, wherein the at least one beauty product is selected from a plurality of differing beauty products, and wherein the method further comprises receiving a selection of the at least one beauty product.

24. The method of claim 23, further comprising enabling the subject to make the selection of the at least one beauty product from the plurality of beauty products.

25. The method of claim 1, further comprising rendering the prognosis on a three-dimensional mesh image.

26. The method of claim 25, further comprising generating a mathematical model corresponding to a three-dimensional image resulting from the rendering of the prognosis on the three-dimensional mesh image.

27. The method of claim 3, further comprising enabling modification of the representative image based on an input by the subject.

28. The method of claim 27, wherein the input by the subject further comprises at least one of the addition and removal of wrinkles from the representative image.

29. The method of claim 28, wherein said at least one of the addition and removal of wrinkles comprises modifying at least one parameter associated with a mathematical model corresponding to the image.

30. The method of claim 26, wherein generating at least one prognosis comprises modifying at least one parameter associated with the mathematical model.

31. A system for enabling determination of prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representation of the subject's external body condition;

a database for storing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for modifying the representation, based on information contained in the database, to generate at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and

a driver for outputting the prognosis to enable the subject to receive the prognosis.

32. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

means for receiving at least one representation of the subject's external body condition;

means for maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

means for generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and
means for outputting the prognosis to enable the subject to receive the prognosis.

33. The system of claim 32, further comprising means for enabling the subject to receive instructions relating to obtaining of the representation.

34. The system of claim 33, wherein the instructions comprise instructions relating to capturing of an image with an image capture device chosen from a web cam, a digital camera, and a scanner.

35. The system of claim 32, further comprising means for constructing a representative image, wherein said means for generating the prognosis compares the constructed image to the information in the database.

36. The system of claim 32, wherein the representation comprises at least one representative image of the external body condition, wherein the information in the database comprises image morphing information, wherein said means for generating the prognosis comprises means for morphing the representative image based on the image morphing information.

37. The system of claim 32, wherein the means for receiving comprises means for receiving the representation image data via a network.

38. The system of claim 32, wherein the representation is stored in a data storage device, and wherein said means for receiving the representation comprises means for receiving the data storage device.

39. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing beauty products.

40. The system of claim 39, wherein the means for outputting further comprises means for outputting product information to enable the subject to be informed about a beauty product relating to the information in the database used to generate the prognosis.

41. The system of claim 32, wherein the information in the database comprises a plurality of subsets of information, wherein at least some of the subsets of information relate to differing manners of using a beauty product.

42. The system of claim 41, wherein the means for outputting further comprises means for outputting usage information to enable the subject to be informed

about the manner of beauty product usage relating to the information in the database used to generate the prognosis image.

43. The system of claim 41, wherein the manners of using differ from one another according to at least one of timing of product usage, the length of time while the product is used, the frequency of use of the product, the length of time between each use of the project, the manner in which the product is applied, an applicator device used to apply the product, and the manner of using the applicator device.

44. The system of claim 32, further comprising means for outputting product purchase information enabling the subject to purchase the beauty product relating to the information in the database used to generate the prognosis.

45. The system of claim 32, wherein the means for generating the prognosis comprises means for comparing the representation with information in the database and selecting a portion of the information in the database based on the comparing.

46. The system of claim 32, wherein the means for outputting the prognosis comprises means for transmitting the prognosis via a network.

47. A system for enabling determination of a prognosis for an external body condition of a subject, the system comprising:

a memory for receiving at least one representative image of the subject's external body condition;

a secondary storage storing a mesh frame representative of at least one part of human anatomy;

a database containing information on how use of at least one beauty product affects evolution of the external body condition;

a processor for rendering the image on the mesh frame and for modifying the image, based on information contained in the database, to generate at least one prognosis image reflecting predicted changes in the external body condition after use of the at least one beauty product; and

a driver for outputting the prognosis image to enable the subject to view the prognosis image.

48. A computer-readable medium which stores a set of instructions which when executed performs a method for enabling determination of a prognosis for an external body condition of a subject, the method comprising:

receiving at least one representation of the subject's external body condition;

maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition;

generating, based on both the representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product; and
outputting the prognosis to enable the subject to receive the prognosis.

X. Evidence Appendix

None

XI. Related Proceedings Appendix

None